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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,150	04/22/2004	Shouhei Kozakai	0171-1085PUS1	5728
2292	7590	02/03/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/829,150	Applicant(s) KOZAKAI ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The Examiner notes for the record that the paragraph in the specification bridging pages 2 and 3 is confusing in that it is not clear which embodiments discussed therein relate to the prior art (i.e. Japanese Patent 2,984,549) and which relate to the disclosed invention. For example, note that the "silicone adhesive layer" referred to at page 3, line 5 is believed to refer to an element of the claimed dicing/die bonding tape, but this is not completely clear when one reads the above cited passage. The Examiner suggests that applicants amend this paragraph in a manner that will make the disclosure perfectly clear but without, of course, adding any new matter.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. More particularly, it appears to the Examiner that an essential element of the invention is that in claim 1, line 2 the fact that the silicone adhesive should read so that it is "directly on", i.e. adjacent the substrate, and in similar fashion in claim 1, line 3 the fact that the bonding layer should read that it is "directly on" the silicone adhesive layer are in each instance critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is, however, noted that the range of tack strengths set forth between the silicone adhesive layer and the bonding layer would clearly appear to require that these two layers be "directly on" one another.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Umehara et al, taken either individually or in view of JP Abstract 2002-256236.

Umehara et al discloses (note particularly Figures 1 and 2, Col 1, lines 16-Col 2, line 11, Col 3, lines 60-67, Col 5, lines 9-33, lines 50-62, Col 6 lines 8-14) one not so readily apparent embodiment wherein resin film layer 3 which can be, e.g. PET (Col 5, lines 10-11) has on one surface a silicone based release adhesive (Col 3, lines 22-30) which is itself adjacent on its opposing outer surface to polyimide adhesive layer 4, which layer can also contain (Col 6, lines 8-12) an epoxy resin as well as other conventional additives such as, it is believed, epoxy resin curing catalysts. Additionally, as regards the tack strength parameter range between the silicone adhesive and the polyimide based adhesive layer 4 this is believed to be either inherent, since it involves two compositions which appear to be the same or equivalent ingredients to those which applicants utilize, or, alternatively, are taken from the same field of technology as the claimed invention. Alternatively to the above discussion concerning polyimide layer 4 the secondary reference JP '236 discloses, as applicants' appear to be aware, the claimed polyimide-epoxy-epoxy resin curing catalyst adhesive layer as applicants claim in a closely related die bonding adhesive sheet. As such the references are believed to be clearly combinable in the manner indicated since they are taken from the dicing/die

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bonding adhesive tape art, with one of ordinary skill making the above modification in the expectation of obtaining improved dicing/die adhesion tape bonding articles. With respect to the dependent claims those adhesive compositions such as found in claims 4-6 are each believed to be, if not either expressly or inherently disclosed, well known subgenuses of the various ingredients, in the absence of unexpected results.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note particularly the PGPub of the present invention, US 2004/0213994, Kozakai et al, as well as the PGPubs, US '132 and '076 (each Kozakai et al) to two of the four coinventors; Curcoi et al and JP Patent Abstract (and machine translation), 08-027239, an equivalent of Japanese Patent 2,984,549 cited in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

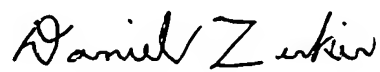
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
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A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.